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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,869	08/30/2001	Pascal Arnaud	212527US0	7528
22850	7590	01/28/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			YU, GINA C	
			ART UNIT	PAPER NUMBER

1617

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/941,869

Applicant(s)

ARNAUD, PASCAL

Examiner

Gina C. Yu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 and 58-97 is/are pending in the application.
- 4a) Of the above claim(s) 53-57, 60, 61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52, 58-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Receipt is acknowledged of Amendment filed on October 23, 2003. Claims 1-42, 44-97 are pending, of which claims 53-57, 60, and 61 are withdrawn from consideration. Claim rejections made under 35 U.S.C. § 112, second paragraph are withdrawn in view of applicants' claim amendment. Claim rejections made under 35 U.S.C. §§ 102 and 103 are withdrawn in view of applicants' claim amendments. New rejections are made.

### ***Election/Restrictions***

Newly submitted claims 60 and 61 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the invention is directed to process of use. As explained in the previous Office action dated September 24, 2002, the process of caring for or making up the lips or the skin for reducing can be practiced with a materially different composition than the claimed invention, such as petroleum jelly or other well known prior art compositions. Similarly, the method of "reducing or even preventing altogether the transfer of a film of composition" can be practiced with prior arts such as WO-A-96/4004 as admitted by applicants.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 53-57, 60, and 61 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-42, 44-52, 58, 59, 83, 85, 86, 91, 96, and 97 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The new limitations in claims 1 and 52 recite “amount insufficient to cause at least one condition selected from the group consisting of a matte appearance, the sensation of dryness, the sensation of tautness and the sensation of discomfort on the keratin material after application of said composition to the keratin material”. It is not clear what this amount is. Examiner notes that specification p. 3, lines 15 – 18 states that the composition is irritating when the volatile oil is “high (typically greater than 30 %)”. On the other hand, applicants disclose in specification p. 19, bridging paragraph, that the present invention contain little or no volatile oil, in particular, less than 5 % by weight. Does 30 %, 5 %, or 0 % by weight of a volatile oil meet the claimed limitation? No specific value is given to determine the metes and bounds of the claimed limitation.

The remaining claims are rejected as they are based on indefinite base claims.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-3, 5-10, 11, 18, 29-31, 35-40, 42-43, 46, 48, 50-52, 58, 59, 62-70, 82-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacks et al. (US 5690918) in view of Fogel (US 6126951).

Jacks teaches a cosmetic lipstick composition comprising a non-volatile hydrocarbon oil (isononyl isononanoate, MW 284,48 g/mole); a non-volatile silicone polymer; 1.9 % of mica and acrylate copolymer (particulate), dyestuff 10 % by weight (Red and Red 6), diisoarachidyl dilinoleate (dispersant), and paraffin. See Example 2; instant claims 1-9. While the formulation contains 34.50 % cyclomethicone by weight in the formulation, the reference in general teaches that the total amount of volatile solvent for the invention is in the range of 1-68 % by weight. See col. 4, lines 8 – 39.

Fogel teaches that it is well known in cosmetic art that the use of cyclomethicones or cyclic silicones, although widely used for delivery vehicle for dermatological composition, have been under scrutiny for safety concerns and “untoward” effects. See col. 1, lines 22 – 30; col. 2, lines 31 – 45; col. 3, lines 37 – 57.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Jacks composition by lowering the amount of cyclomethicone as motivated by Fogel because of the concerns of safety and undesirable effects associated with cyclomethicones.

2. Claims 1-10, 24-30, 32-35, 37-42, 44-52, 62-69, 80, 82, 83, 85-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul et al. (US 5738841) in view of Fogel (US 6126951).

Mellul teaches a cosmetic lipstick composition comprising 60 % octyldodecyl neopentanoate (non-volatile hydrocarbon oil), 0.1 diphenyldimethicone, 5% alkyldimethicone (silicone compounds), 12 % pigments. See examples 5 and 6; instant claims 1-10, 62-69, 91-95.

The reference teaches using octyldodecyl neopentanoate in 0.5-99 % by weight. See col. 2, lines 30 – 33; instant claims 32-35, 82. The nonvolatile silicone of instant claims 28 and 79 are taught in col. 2, line 47 – col. 3, line 6. The pigments, fillers, and conventional cosmetic additives are taught in col. 3, lines 32 – 45. See instant claims 40-45, 83, 85-90. The reference teaches cyclomethicones (a volatile silicone oil) is alternatively used in place of nonvolatile oils such as polydimethylsiloxanes or phenyltrimethicones. See col. 2, lines 47 – col. 3, line 6.

Fogel teaches that it is well known in cosmetic art that the use of cyclomethicones or cyclic silicones, although widely used for delivery vehicle for dermatological composition, have been under scrutiny for safety concerns and “untoward” effects. See col. 1, lines 22 – 30; col. 2, lines 31 – 45; col. 3, lines 37 – 57.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Mellul composition by lowering the amount of cyclomethicone or not using cyclomethicone as motivated by Fogel because of the concerns of safety and undesirable effects associated with cyclomethicones.

3. Claims 11-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul and Fogel as applied to claims 1-10, 24-30, 32-35, 37-42, 44-52, 62-69, 80, 82, 83, 85-97 as above, and further in view of JP 63119412.

Mellul and Fogel, discussed above, do not teach poly(hydroxyl-12) stearic acid.

JP 63119412 abstract teaches 12-hydroxystearic acids is well known in lipstick art, and that the compositions having 12-hydroxystearic acid along with polyhydric

alcohol esters of rosin, fatty acids with polyhydric alcohol gives improved luster and good dispersion of color. See abstract.

It is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of conventional lipstick agents. It would follow that the recited claims define prima facie obvious subject matter.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have added 12-hydroxystearic acid as motivated by JP 63119412 because of the expectation of successfully producing a lipstick composition.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 62-82, 84, 87-90, and 92-95 are pending are rejected under the judicially created doctrine of double patenting over claim 9 of U. S. Patent No. 6326012 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Both sets of claims are directed to makeup compositions, particularly lipstick composition comprising a) at least one non-volatile hydrocarbon-based oil; b) at least one-volatile silicone compound which is compatible with a); c) inert fillers (see claim 22 of 09/728056), within overlapping limitations.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### **Conclusion**

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina Yu  
Patent Examiner

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**

1/26/04